

## **REMARKS/ARGUMENTS**

This communication is in response to the Final Office Action dated January 5, 2010. Claims 7 and 16 have been canceled, without prejudice, and the subject matter incorporated into independent claims 1 and 12, respectively. New dependent claims 17 and 18 have been added. Claims 1, 2 and 12 have been amended. No new matter has been added. Claims 1-6, 8-15, 17 and 18 remain pending in this application with claims 1 and 12 being the only independent claims. Reconsideration is respectfully requested.

### **Traverse Finality of Outstanding Office Action**

As a preliminary matter, Applicant respectfully traverses the finality of the outstanding Office Action. MPEP § 706.07(a) provides that “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.17(p)”. In the present applicant, claim 2 is rejected for the first time under 35 U.S.C. § 112, second paragraph in the outstanding Office Action. The basis for the rejection was the limitation “the original e-mail address.” This limitation was not amended by Applicant in the October 19, 2009 Amendment. Accordingly, the new grounds for rejection of claim 2 was not necessitated by any amendment by applicant. Therefore, the finality of the action is premature and applicant requests that it be withdrawn.

### **Entry of Amendment**

Assuming, *arguendo*, that the Examiner is not persuaded to withdrawal the finality of the outstanding Office Action, Applicant nevertheless requests that the Amendment to the claims be entered since they do not necessitate additional search and/or consideration. Independent claims 1 and 12 have been amended to incorporate the subject matter previously found in dependent claims 7 and 16, respectively. New dependent claims 17 and 18 correspond to claims 10 and 11.

Accordingly, no additional search and/or consideration is required. The amendments to claim 2 are non-substantive merely to overcome the outstanding claim objection and provide proper antecedent basis for a term. Accordingly, entry of the amendments to the claims and consideration of the arguments presented below is requested.

### **Claim Rejection Under 35 U.S.C. §112, Second Paragraph**

Claim 2 is rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that the limitation “the original e-mail message” in lines 3-4 of claim 2 lacks proper antecedent basis. Applicant has deleted the term “original” from claim 2 wherein proper antecedent basis for the limitation is now found in claim 1, line 6. Withdrawal of the rejection in view of the amendment to claim 2 is therefore requested.

### **Prior Art Rejections**

Claims 12-14 and 16 are rejected under 35 U.S.C. §103(a) as obvious over Laumen et al. (US Patent Application Publication No. 2003/0086438) in view of Fenton (US Patent Application Publication No. 2003/0193951).

Claims 1-8 and 10-15 are rejected under 35 U.S.C. §103(a) as obvious over Laumen et al. in view of Gabriel et al. (U.S. Patent Application Publication No. 2004/0082348) and Fenton.

Claim 9 is rejected under 35 U.S.C. §103(a) as obvious over Laumen et al. in view of Gabriel et al., Fenton and Ala-Luukko et al. (U.S. Patent Application Publication No. 2003/0064706).

Applicant respectfully traverses the prior art rejections for the reasons discussed in detail below.

### **Independent Claim 1**

Independent claim 1 specifies “wherein the e-mail is transmitted from a sender via a polled e-mail server to the recipient” and that “the e-mails are forwarded from the polled e-mail

server to a specially configured push mail server.”

The Examiner maintains that RSA 2 reads on the claimed “polled e-mail server”, while RSB 12 reads on the claimed “push mail server.” Applicant respectfully disagrees. These two elements (e.g., RSA and RSB) represent the same type of element, i.e., both are MMS Relay/Servers. Since both of these elements represent the same type of component (e.g., MMS Relay/Server) one cannot represent a polled e-mail server while the other represents a push mail server. To the contrary, both RSA and RSB represent two push mail servers. Accordingly, Laumen et al. fails to disclose or suggest “a polled e-mail server.”

The Examiner acknowledges that Laumen et al. fails to disclose “a polled e-mail server” but submits that Fenton teaches this missing limitation. Applicant submits that modification of Laumen et al. as taught by Fenton to include one polled e-mail server would render Laumen et al. unsatisfactory for its intended purpose of recalling or replacing an MMS message that has already been sent. MPEP §2143.01(v) provides “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)) The intended purpose set forth in Laumen et al. (e.g., recalling or replacing an MMS message after it has already been sent) teaches away from any modification to include sending of a message from a polled e-mail server to a pushed e-mail server.

Claim 1 has been amended to incorporate the limitation previously found in claim 7 that specifies “wherein the push mail server encapsulates the e-mail in a suitable content type, so that the e-mail can be transmitted via MMS or WAP push format.” (emphasis added) Applicant traverses the Examiner’s assertion that the limitations previously set forth in claim 7 are taught by paragraph [0041] of Laumen et al. This paragraph of Laumen et al. teaches transmission of a MMS multi media message MM<sub>A</sub> via WAP, which is a standard procedure not requiring encapsulation of the message. Therefore, Laumen et al. fails to disclose or suggest transmission of an e-mail via MMS or WAP by encapsulating this e-mail in a suitable content type, as found in amended claim 1.

Independent claim 12 is the apparatus counterpart of method claim 1 and thus patentable over the prior art of record for similar reasons to those described above with respect to claim 1.

### **Dependent Claim 2 and 15**

Claim 2 states “a subscriber account is established for each subscriber on the push mail server, the subscriber account including the telephone number of at least one telecommunication terminal and the e-mail address of the recipient.” (emphasis added) In Laumen et al. there is no disclosure or suggestion for creating such an account including both pieces of information. There is no need or motivation to create such an account based on the two pieces of information since both service providers are MMS service providers. The Examiner acknowledges that Laumen et al. fails to disclose this limitation but relies on Gabriel et al. as a secondary reference to teach this feature. Gabriel et al. discloses “To use this feature of the system a user can create a regular SMS message in the user’s email program, and addresses the message to the desired recipient’s telephone number at the management server’s address (recipient’snumber@managementserver.com).” {Paragraph [0233]} Thus, in Gabriel et al. the user themselves must address the message to the desired recipient’s telephone number at the management server’s address, whereas in the present claimed invention this function is performed by the push mail server based on the subscriber account. All the user is required to supply with the e-mail message is the recipient’s e-mail address. No teaching or suggestion in either Laumen et al. or Gabriel et al. is found for a subscriber account being established for each subscriber on a push mail sever, wherein “the subscriber account including the telephone number of at least one telecommunication terminal and the original e-mail address of the recipient,” as found in claim 2.

Furthermore, Gabriel et al. discloses a subscriber account including a telephone number (receipient’snumber@managementserver.com) {paragraph [0233]} and that “a user’s account can also be set up to receive SMS messages via email.” {paragraph [0234]} Accordingly, Gabriel et al. discloses the account being based on either the telephone number or the e-mail address, but not both, as called for in claim 2.

Claim 15 contains a limitation similar to that found in claim 2 and thus is patentable over the prior art of record for at least the same reasons discussed above with respect to claim 2.

### **Dependent Claim 5**

Claim 5 calls for “wherein the push mail server is connected to the MMS or WAP push systems of the employed telecommunication network.” The Examiner maintains that MMS Relay/Server RSB reads on the claimed “push mail server.” The MMS Relay/Server RSB is in fact part of the MMS push system rather than connected to the push system.

The Examiner failed to address these arguments in the outstanding Office Action. If the Examiner is not persuaded by these arguments, Applicant requests that he specifically point out the reasons why.

### **Dependent Claims 10 and 17**

Claim 10 recites “wherein a conventional WAP client or MMS client, which detects and processes encapsulated e-mails, is installed in the telecommunication terminal.” Once again referring to paragraph [0041] of Laumen et al. on which the Examiner basis his rejection, such limitation as found in dependent claim 10 is neither disclosed nor suggested. Paragraph [0041] of Laumen et al. discloses a receiving application (UAB 11) in the receiving terminal. Suitable receiving applications include, for example, a WAP client or MMS client. Accordingly, Laumen et al. fails to disclose or suggest that the UAB is capable of processing encapsulated messages.

Claim 17 is the apparatus counterpart of method claim 10 and thus patentable over the prior art of record for similar reasons to those described above with respect to claim 10.

### **Dependent Claims 11 and 18**

Claim 11 calls for “wherein, if message units encapsulated with the special content type are detected, the e-mail contained therein is extracted and transmitted to the e-mail client of the telecommunication terminal.” Paragraph [0347] of Laumen et al. teaches that the MMS service uses an e-mail address format for identifying the sender and receiver. However, Laumen et al. neither discloses nor suggests that the MMS client is able to detect e-mail content, specifically, message units encapsulated with the special content type. Furthermore, no teaching is found in Laumen et al. that the e-mail contained in the encapsulated message is extracted and transmitted to a conventional e-mail client of the telecommunication terminal.

Claim 18 is the apparatus counterpart of method claim 11 and thus patentable over the

prior art of record for similar reasons to those described above with respect to claim 11.

For the foregoing reasons, Applicant submits that the claims are patentable over the prior art of record and passage of this application to issuance is therefore requested.

### **CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

### **ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
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